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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,237	09/24/2003	Clark Thomborson	3652-43	2051

23117 7590 08/24/2006

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EXAMINER

AGWUMEZIE, CHARLES C

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/668,237	THOMBORSON, CLARK	
	Examiner	Art Unit	
	Charlie C. Agwumezie	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/18/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 19 and 20, are rejected under 35 U.S.C. 102(e) as being anticipated by Hurtado et al U.S. Patent Application Publication No. 2006/0095792 A1.

As per **claim 19**, Hurtado et al discloses a method of transacting a digital object in which a vendor offers for sale or trade the digital object to a purchaser, the method comprising the steps of:

transferring a digital object from a vendor to an electronic marketplace (figs. 9 and 10);

testing the digital object for authorization violation (0157; 0158; "...checks for watermark and updates watermark as required...");

adding one or more authorization codes to the digital object (0157; 0158); and
storing an identifier of the vendor in computer memory in the event of the digital object violating the authorization test (0478; 0487; storing among other information provider identifier).

As per claim 20, Hurtado further discloses a transaction system in which a vendor offers for sale or trade a digital object to a purchaser, the system comprising:

- an acceptance component configured to receive a digital object for sale or trade (fig. 9, 10, 14 and 16);
- a watermarking component configured to create a watermarked object from the vendor submitted object (fig. 5);
- a recognition component configured to test the digital object for authorization violation (0157; 0158); and
- an enforcement component configured to store data representing authorization violation in computer memory (0157; 0158; 0886).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurtado et al U.S. Patent Application Publication No. 2006/0095792 A1.

As per claims 1, 7 and 13, Hurtado et al discloses a method of transacting a digital object in which a vendor offers for sale or trade the digital object to a purchaser, the method comprising the steps of:

receiving a digital object from a vendor (see figs. 14 and 16);

testing the digital object for the presence of an authorization code (0157; 0158; "...checks for watermark and updates watermark as required...");

associating a warning status with the digital object on detecting the presence of an authorization code in the digital object;

checking a database of vendor details maintained in computer memory (0158; 0027);

associating an alert status with the digital object on detecting an entry in the database of vendor details representing an alert status associated with the vendor;

adding one or more authorization codes to the digital object (0157; 0158); and

updating the entry in the database of vendor details representing the vendor with the warning and/or alert status associated with the digital object (0157; 0227; 0789).

What Hurtado et al does not explicitly teach is associating a warning status with the digital object on detecting the presence of an authorization code in the digital object; associating an alert status with the digital object on detecting an entry in the database of vendor details representing an alert status associated with the vendor.

Saito discloses associating a warning status with the digital object on detecting the presence of an authorization code in the digital object (col. 5, lines 25-40); associating an alert status with the digital object on detecting an entry in the database of

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vendor details representing an alert status associated with the vendor (col. 5, lines 25-40; col. 7, lines 30-35).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Hurtado et al and incorporate a method associating a warning status with the digital object on detecting the presence of an authorization code in the digital object; associating an alert status with the digital object on detecting an entry in the database of vendor details representing an alert status associated with the vendor in view of the teachings Saito in order to ensure that digital object is being accessed by an authorized user.

As per claims 2, 8 and 14, Hurtado et al further discloses a method of transacting a digital object further comprising the steps of:

receiving a vendor identifier representing the vendor from which the digital object is received (0227); and

adding the vendor identifier to the digital object (0227).

As per claims 3, 9 and 15, Hurtado further discloses a method of transacting a digital object further comprising the steps of: extracting the vendor identifier from the digital object;

comparing the extracted vendor identifier with the vendor identifier received from the vendor (0157; 0166; 0793); and

checking the digital object for an associated warning status (0157; 0158).

As per **claims 4, 10, and 16**, Hurtado further discloses a method of transacting a digital object further comprising the step of removing the warning status if the extracted vendor identifier matches the vendor identifier received from the vendor (0227).

As per **claims 5, 11, and 17**, Hurtado et al failed to explicitly disclose a method of transacting a digital object further comprising the step of:

associating a warning status with the digital object if the extracted vendor identifier does not match the vendor identifier received from the vendor.

Saito discloses a method of transacting a digital object further comprising the step of associating a warning status with the digital object if the extracted vendor identifier does not match the vendor identifier received from the vendor (col. 5, lines 25-40; col. 7, lines 30-35).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Hurtado et al and incorporate a method of transacting a digital object further comprising the step of associating a warning status with the digital object if the extracted vendor identifier does not match the vendor identifier received from the vendor in view of the teachings of Saito in order to ensure that digital object is being accessed by an authorized user.

As per claims 6, 12, and 18, Hurtado further discloses a method of transacting a digital object further comprising the steps of:

checking the database of vendor details maintained in computer memory (0158; 0027); and

updating the entry in the database of vendor details representing the vendor with an alert status if the number of warning status indicators associated with the vendor exceeds a predefined threshold (0157; 0227; 0789).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference cited to Stefik et al U.S. Patent Application Publication No. 2006/0059562 A1 is a document considered relevant to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on **(571) 272 – 6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

Or faxed to:

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(571) 273-8300. [Official communications; including After Final communications labeled "Box AF"].

(571) 273-8300. [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"].

Hand delivered responses should be brought to the United States Patent and Trademark Office Customer Service Window:

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401 Dulany Street

Alexandria VA. 22314

Charlie Lion Agwumezie
Patent Examiner
Art Unit 3621
August 15, 2006

JAMES A. REAGAN
PRIMARY EXAMINER

